

Remarks

Reconsideration of this Application is respectfully requested. Claims 7 and 13 are pending in the application, with claim 7 being the only independent claim. The amendment to claim 7 is believed to contain no new matter.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 102

The Hauser '767 Patent

Claims 7 and 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,862,767 to Hauser. Applicants respectfully traverse the rejection. Independent claim 7 recites a hydrostatic transmission is disposed within the same housing as the axles. The Hauser '767 patent does not disclose such an arrangement. Instead the hydrostatic transmission of the Hauser '767 patent is bolted to the axle housing. The Examiner replied to Applicants' argument by stating that the various housings of the Hauser '767 patent, taken together, form a single "housing". Although Applicants believe that the Examiner's response is inconsistent with the history of how similar language has been interpreted throughout the history of this family of patent applications, including as interpreted by the Board of Patent Appeals and Interferences, Applicants have amended the claims to recite that hydrostatic transmission and the axles are disposed within the same cavity formed within the housing. The Hauser '767 patent does not show such an arrangement.

Further, as noted in response to the previous Office Action, the Hauser '767 patent does not disclose pinion gears disposed within a ring gear or that the ring gear is supported by the axles, as also recited in independent claim 7. Accordingly, because the Hauser '767 patent does not disclose every feature recited in independent claim 7, it does not anticipate claim 7.

Claim 13 depends from and adds additional features to claim 7 and is therefore allowable over the Hauser '767 patent for at least the same reasons as claim 7.

Accordingly, Applicants respectfully request that the rejection be removed.

The Nemoto '820 Patent

Claims 7 and 13 were also rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,870,820 to Nemoto. Applicants respectfully traverse the rejection. With respect to claim 7, the present application claims priority under 35 U.S.C. § 120 back to the February 1, 1989 filing date of U.S. Application No. 07/304,581. Priority under 35 U.S.C. § 119 is claimed to Japanese Patent Application No. 63-24193, filed February 3, 1988. A certified translation of the Japanese application was filed in the interferences. A copy of that translation is provided herewith. The February 3, 1988 Japanese application discloses every element of claim 7 of the present application. The Nemoto '820 patent was filed on April 8, 1988. Accordingly, it is not prior art to the present application under 35 U.S.C. § 102(e). Further, the Nemoto '820 patent does not disclose that the hydrostatic transmission is in the same housing as the axles, as the pump is mounted to the outside of the housing.

While the February 3, 1988 application does not disclose the subject matter of claim 13, claim 13 is patentable over the Nemoto '820 patent at least for the reasons

discussed above regarding the location of the hydrostatic transmission within the same housing as the axles. Further, the Nemoto '820 patent does not disclose that the hydraulic pump is located between the hydraulic motor and the axles, as recited in claim 13. During the interview conducted on December 30, 2003, Applicants' representative explained that claim 13 is directed to the embodiment of Figure 15 of the present application. The Examiner stated that he interpreted the recitation that the hydraulic pump is "between" the motor and the axles broadly. Accordingly, Applicants have amended claim 13 to more clearly recite that a longitudinal axis of the hydraulic pump is disposed a first distance from a longitudinal axis of the axles, and a longitudinal axis of the hydraulic motor is disposed a second distance from the longitudinal axis of the axles, wherein the first distance is smaller than the second distance. In other words, the distance from hydraulic pump to the longitudinal axis of the axles is shorter than the distance from the hydraulic motor to the longitudinal axis of the axles. This feature is not disclosed in the Nemoto '820 patent.

Accordingly, the Nemoto '820 patent is not prior art to claim 7 of the present application and does not disclose every feature of claims 7 and 13. Therefore, the Nemoto '820 patent does not anticipate claims 7 and 13.

Inventorship

Claims 7 and 13 were also rejected under 35 U.S.C. § 102(f) because the Examiner alleges that the Applicants did not invent the subject matter of the invention. As explained to the Examiner during the interview conducted on December 30, 2003, the present claims and the claims in the interferences are not the same. Inventorship is determined on a claim-by-claim basis. Further, the essential decision of the Board in the

interferences was that the party Okada in the interferences was not timely in its request to correct inventorship, and that the declarations in support of the correction of inventorship did not explain why Mr. Okada changed his mind regarding inventorship. Those factors are not relevant in this *ex parte* context. Accordingly, absent interference estoppel, which has not been asserted by the Examiner, Applicants may correct inventorship, if necessary. However, as discussed in more detail below, Applicants assert that inventorship as currently listed *for the pending claims* is correct.

In conducting the inventorship analysis in this case, one must take into consideration the fact that claim 13 of Interference No. 104,496 ("the '496 interference") was found to be unpatentable by the Board. As the Examiner knows, if someone's contribution to an invention is merely that which was known in the prior art, then that person is not an inventor under the patent law. Claim 13 of the '496 interference, which was found by the Board to be unpatentable, stated as follows:

13. An axle driving apparatus, comprising:
 - a housing;
 - a hydrostatic transmission completely within said housing;
 - axle shafts extending from said housing;
 - differential gearing means completely within said housing operatively connecting said hydrostatic transmission and said axle shafts;
 - said housing being defined by at least two separable housing elements detachably joined together along a horizontal plane.

Comparing claim 13 of the '496 interference to currently pending claim 7 of this application, one finds that the differences between the two are the following elements which are found in claim 7 of the present application:

a pair of bevel gears, one disposed on each axle of said pair of axles;

a ring gear coupled to said output shaft of said hydraulic motor; and

a pair of pinion gears disposed within said ring gear and coupled to said pair of bevel gears, whereby said ring gear is supported within said housing by said pair of axles.

Because the elements that are the same as the elements of claim 13 from the '496 interference are, according to the Board, "in the prior art", it is the inventor or inventors of these additional elements who should be named as the inventor(s) of claim 7 of the present application. Mr. Okada contributed these elements to the present invention and therefore, he is the sole inventor of claim 7.

Proof that Mr. Okada is the contributor of these elements is evidenced in Exhibit 1140 from the interferences, a copy of which is attached hereto. Exhibit 1140 which was created prior to the present invention, shows concepts to which Mr. Okada admittedly did not contribute. Exhibit 1140 was relied upon by Okada in the interferences to add the creators of the concepts contained therein, as co-inventors of related applications. However, as can be seen, the novel concepts of the present claim 7 are not disclosed in Exhibit 1140. It was Mr. Okada alone who contributed these concepts to the present invention. Thus, inventorship as to claim 7 is correct.

Regarding claim 13 pending in the present application, the arrangement of the pump, motor, and axles claimed is found in item 2 of Exhibit 1140. However, as supported by the declarations filed in the interferences, it was Mr. Nemoto who contributed the concept of placing the pump between the motor and the axles to item 2 of

Exhibit 1140. Accordingly, Mr. Nemoto is properly named as a co-inventor of the present application due to his contributions to claim 13.

In accordance with the reasoning provided above, Applicants respectfully request that the rejections be withdrawn.

Interference Estoppel

As noted above, interference estoppel under 37 C.F.R. §1.658(c) was discussed during the interview. First, the Examiner has not asserted interference estoppel as a basis for his rejection. Further, as discussed during the interview, Applicants assert that claim 7 is patentably distinct from the counts of the interferences, and therefore interference estoppel does not apply.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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